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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PHAM, THIERRY L

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/479,913	<b>Applicant(s)</b> KLATT ET AL.	
	<b>Examiner</b> THIERRY PHAM	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2012.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-21, 23-34, 36-53 and 55-91 is/are pending in the application.
- 5a) Of the above claim(s) 10-16, 25-29, 38-42, 44-50 and 55-78 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-9, 17-21, 23-24, 30-34, 36-37, 43, 51-53, 79-91 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

- This action is responsive to the following communication: RCE filed on 02/01/2012.
- 1-21, 23-34, 36-53, 55-91 are currently pending; claims 10-16, 25-29, 38-42, 44-50, 55-78 have been withdrawn; claims 83-91 are newly added.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/1/2012 has been entered.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

---Claim 7 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

For example, selecting and generating steps as cited in claim 5 of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The disclosure has provided no explicit and deliberate

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definitions of selecting and generating steps to limit the steps to be performed only by the an apparatus or system, and the claim language itself is sufficiently broad to read on a user manually selecting and generating print order (e.g. selecting options on an order form to create a print order when changes in sales management database occurred). All the steps as described above do not need to be performed by an apparatus or device.

---Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 is claiming a computer program (e.g. user interface is a computer program) per se, which does not mount/store on any computer-readable medium; therefore, said claim 9 is rejected for non-statutory basis. The examiner herein recommends said program to be stored on a tangible/non-transitory computer readable medium, so it compliances with **35 U.S.C. 101**.

---Claims 30-34, 36-37 recite a computer-readable recording medium, but neither the claim nor the disclosure limit the medium to the statutory embodiments. Such recitation could be reasonably understood to include computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the Applicant in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the examiner suggests the following approach: a claim drawn to such a computer readable recording medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim, i.e., reciting "a non-transitory computer-readable recording medium".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 17-21, 23-24, 30-34, 36-37, 43, 51-53, 79-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell et al (US 5717841) and in view of Yaksich et al (US 5563999).

Regarding claim 1, Farrell discloses a system (figs. 1-2) comprising:  
a processor (controller 7, fig. 2) configured to receive first input (fig. 9) that selects an item (*inactive print jobs to be printed when events are triggered, cols. 6-10*) to be printed and second input that selects an event (*trigger event rules/parameters, fig. 5b, 9-12, col. 6, lines 45-65 and cols. 9-10*) from a menu of events relating to activity in a database (*database, cols. 9-10*); and  
storage (*fig. 5b, and col. 9, lines 20-65*) configured to store an event rule that relates the event and the item, wherein the processor is configured to generate a print order (*inactive print jobs to be generated and printed, figs. 5b, 9-12*) the item in response to occurrence of the event (*inactive print jobs to be printed when events are triggered, cols. 6-10*).

Farrell discloses trigger events associated with a database in general (col. 9, lines 9-10, col. 11, lines 28-60), but fails to expressly indicate such database include sale management database and a sales packet, and wherein an event includes at least one of addition of a new sales contact or a change of status of an existing sales contact.

Yaksich, in the same field of endeavor for printing, teaches a well-known system that includes a sales management database (sales of business forms database, figs. 1-8) and a sales packet (business forms, fig. 3), and wherein an event includes at least one of addition of a new sales contact or a change of status of an existing sales contact (col. 69, line 60 to col. 70, line 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Farrell to include plurality of databases (e.g. sales management database) and a sales packet, and wherein an event includes at least one of addition of a new sales contact or a change of status of an existing sales contact. Both Farrell and Yaksich teach advantages of generating print orders based upon triggers events (see columns 1-2 of both references).

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Therefore, it would have been obvious to combine Farrell with Yaksich to obtain the invention as specified in claim 1.

Regarding claim 2, Yaksich further teaches the system of claim 80, wherein the processor is further configured to include data from the at least one of the data field (cols. 49-50) or the data table in the print order. .

Regarding claims 3-5, Farrell further discloses the system of claim 1, wherein the processor is further configured to receive third input that specifies a destination/times/dates for an output of the print order (col. 6, lines 50 to col. 7, lines 25).

Regarding claim 6, Yaksich further teaches the of claim 1 system for designating rules according to claim 1, wherein the item is one of a set of items that related to different versions of sale packets (different versions of business forms, cols. 1-2).

Regarding claims 7-8, 17-21, 23-24, 30-34, 36-37, 43, 51-53 which recite limitations that are similar and in the same scope of invention as to those in claims 1-6 above and/or combination thereof; therefore, claims 7-8, 17-24, 30-37, 43, 51-54 are rejected for the same rejection rationale/basis as described in claims 1-6 above and/or combination thereof.

Regarding claim 79, Farrel further teaches the system of claim 1, further comprising a display having a first display region configured to display the item (inactive print jobs to be printed when events are triggered, cols. 6-10) to be printed and a second display region configured to display the menu of events (trigger event rules/parameters, fig. 5b, 9-12, col. 6, lines 45-65 and cols. 9-10) associated with the sales management database.

Regarding claim 80, Farrell further teaches the system of claim 1, further comprising a monitoring (figs. 9-10) component configured to monitor at least one of a

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data field or a data table in the sales management database for the occurrence of the event.

Regarding claim 81, Farrell further teaches the method of claim 7, wherein the detecting the occurrence of the event includes monitoring at least one of a data or a data table of the sales management database.

Regarding claim 82, Farrell or Yaksich further teaches the method of claim 24, wherein the transmitting includes transmitting the event over the Internet (network, figs. 1-2). Furthermore, Internet network is widely implemented and available in the art. The examiner herein takes official notice that Internet network is well-known and can be easily combine to achieve the claimed invention.

Claims 83-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell and Yaksich as applied to claims 1-9, 17-21, 23-24, 30-34, 36-37, 43, 51-53 above, and further in view of Sevcik et al (US 6330542).

Regarding claim 83, Farrell and Yaksich fail to teach and/or suggest sending print order to print vendor.

Sevcik, in the same field of endeavor for printing, teaches sending print order to print vendor (fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify system of Farrell and Yaksich to include step of sending print order to print vendor as taught by Sevcik to fulfill print orders that with lowest possible prices.

Therefore, it would have been obvious to combine Farrell and Yaksich with Sevcik to obtain the invention as specified in claim 83.

Regarding claim 84, Sevcik further teaches the system of claim 83, wherein the processor is further configured to receive third input specifying a maximum cost (col. 13, lines 20-55) of fulfilling the print order and to select the printing vendor based on the

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maximum cost (col. 10, lines 1-4), and wherein the storage is further configured to store the third input with the event rule.

Regarding claim 85, Sevcik further teaches the system of claim 83, wherein the processor is further configured to: generate, in response to the occurrence of the event, a shipping order that schedule pick-up (col. 9, lines 25-50) of a product generated in response to the print order, wherein the shipping order indicates a time that the product is to be picked up; and send the shipping order to a shipping vendor.

Regarding claims 86-91 recite limitations that are similar and in the same scope of invention as to those in claims 83-85 above; therefore, claims 86-91 are rejected for the same rejection rationale/basis as described in claims 83-85.

### ***Response to Arguments***

Applicant's arguments filed 2/1/2012 have been fully considered but they are not persuasive.

---Regarding independent claims, the applicants argued the cited prior arts of record fail to teach and/or amended features/limitations as cited in independent claims.

In response, the examiner herein fully disagrees. Yaksich clearly teaches a well-known system that includes a sales management database (sales of business forms database, figs. 1-8) and a sales packet (business forms, fig. 3), and wherein an event includes at least one of addition of a new sales contact or a change of status of an existing sales contact (col. 69, line 60 to col. 70, line 8).

*(130) The forms automation system 10 in this particular example is used to automate the ultimate customer interview process that occurs when new accounts are established at a banking institution, or changes are made to existing accounts. The exact detail of the processing performed during the customer(bank's) interview will determine the forms which are to be printed. For example opening of checking accounts, time deposit accounts, and savings*

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*accounts **will generate different forms that are ultimately printed.** In addition to printing the electronic forms, the forms automation system 10 according to the invention will produce a check list of all forms printed as **a result of specific activity on an account,** and all forms required to document an interview will be printed immediately at the completion of the interview process so that the bank's customer will have--before he or she leaves the bank--a paper form. Three to five bank customer interviews can take place concurrently and the common data for each will automatically be transferred from one electronic form to the other.*

The cited paragraph above clearly teaches wherein sales packets (e.g. bank account forms, brochure, and etc) will be printed when new accounts are established or changes are made to existing accounts on bank institution's management databases (e.g. equivalent to sales management databases).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/

Primary Examiner, Art Unit 2625